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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,329	03/01/2002	Takashi Nara	47793/57534	3044
21874 7590 07/01/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER				
DAGNEW, SABA				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
07/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/087,329

Applicant(s)

NARA ET AL.

Examiner

SABA DAGNEW

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 13 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/01/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 31st and April 30 2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12, 13 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Exercise machine" (e.g., in claim 12 at line 3) is new matter.

The spec. does not disclose "machine" or "exercise machine". Applicant argues (p. 5) that there are examples of exercise machines on spec. p 15. The examiner agrees, but the disclosure of several species does not entitle an applicant to claim a genus. Furthermore, at least one of the examples, the dumbbell, is hardly a machine.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (U.S. Patent Number 5,578,808).

With respect to claims 12 and 17, Taylor teaches a point-giving server for giving a user points and a program embodied on computer-readable medium for performing a point-giving procedure which gives a point to user, the point-giving server (**data card 10, col. 3 line 20 and Fig. 1**), comprising:

a data acquiring unit, said data acquiring unit operable to communicate with an exercise machine that allows a user to exercise (**Col. 5, lines 27-38, where "a computer" reads on an exercise machine**) and acquire a character string or image (**Col. 5, lines 63-67 and Col. 6, lines 1-4, where "PIN Number and Vendor Access Code" reads on character string**);

a converter operable to convert said character string or image acquired by said data acquiring unit to points (**Fig. 6A, 17A, where Fig. 6A teaches translating cash value to points**) which are accumulated as mileage points of an airline or card points of a credit card company (**Col. 2, lines 1-8**) by using a point converting table which makes said character string or image correspond to said points the accumulated points being in proportion to an amount of service used (**Fig. 1 and Col. 3, lines 21-40, where "record" section in Fig. 1 table, contains accumulated points**); and

an output unit operable to output said points generated by said converter to increase points accumulated for said user (**Col. 7, lines 24-50**).

Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used

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to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.

The instant application contains no such clear definition for the phrase “exercise machine”. Indeed, the word “machine” does not appear in the spec. Applicant argues (p. 5, top) that the term is defined by examples at spec. p. 15, but it is noted above that examples are not sufficient to establish a “clear definition”. In the instant case, the examiner is required to give the term “exercise machine” its broadest reasonable interpretation, which the examiner judges to be machine useful for exercise. The “computer” taught by the reference reads on that because it is useful for getting exercise information and tracking fitness progress.

With respect to claim 13, Taylor teaches all elements of claim 12, furthermore, Taylor teaches a point-giving server wherein said data acquiring unit acquires a plurality of types of character strings or images (**Fig. 4, where the Table contains a plurality of “PIN Numbers and Vender Access Code” which reads on character string**) ; and

said converting table makes combination of said plurality of types of character string or image to a plurality of points, respectively and converts each of said combination of said plurality types of character strings or image to corresponding points (**Fig. 1, Fig. 4 and Col. 3, lines 21-40, where “record” section in Fig. 1 table, contains plurality of converted and accumulated points**).

Response to Arguments

Applicant's arguments filed on 30th April 2008 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection. In particular, it has been explained that a "computer" meets the examiner's broadest reasonable interpretation of "exercise machine" under the law.

The present rejection could be overcome by claiming one or more of the exercise tool species disclosed on spec. page 15. All could be claimed as a Markush group (MPEP § 803.02).

Conclusion

This is a continuation of application of applicant's earlier Application No. 10087329. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

It is noted in particular that the examiner explained the principles of "clear definition" and "broadest reasonable interpretation" in the advisory action mailed on 11 April 2008. Applicant was thereby put on notice that amending to another genus without "clear definition" could not distinguish over the prior art.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D./
Examiner, Art Unit 3688

/Donald L. Champagne/
Primary Examiner, Art Unit 3688